

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of: Mark Falahee

Application No.: 10/689,124

Confirmation No.: 2910

Filed: October 20, 2003

Art Unit: 3734

For: RADIOPAQUE MARKING PEN

Examiner: D. Yabut

APPELLANT'S REPLY BRIEF

Mail Stop APPEAL BRIEF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to new arguments raised in the Examiner's Answer mailed June 30, 2009, Appellant hereby submits its Reply Brief.

In the Response to Arguments section of the Examiner's Answer, page 6, the Examiner states that the device of Palasis is characterized by "an elongate, cylindrical, or pen-shaped member 22 ...". The Examiner implies that all elongate, cylindrical devices are also "pen-shaped," which is not the case. Given that the device of Palasis is a flexible hose, it would not be considered "pen-shaped." Nor would a common garden hose be considered pen-shaped.

Appellant is still unclear as to what the Examiner means in rejecting claims 9 and 14. In the Examiner's Answer, the Examiner states that "the examiner clarified that the motivation for modifying the fluid substance of Palasis by using powder was for the substance to be 'easily removed from the skin or surgical film when undesired' or 'easily removed from the surgical site being x-rayed,' and not necessarily requiring penetration of the skin." (Examiner's Answer, bottom of page 6, top of page 7.) As best understood by Appellant, the Examiner's argument seems to be that powder is somehow more easily removed than a liquid. Apart from Appellant disagreeing with this assessment on the grounds that it depends what type of liquid or powder is being applied, there

is no evidence in the record of what is or is not easily removed, nor does this argument address Appellant's claim limitations.

Appellant also does not fully understand the rejection of claim 16. The Examiner argues that it would have been obvious to one of skill in the art that erasable ink is commonplace, allowing errors to be conveniently corrected "by erasing them." In any case, method claim 16 adds to claim 13 the step of erasing an indication if not optimized by the procedure. Claim 13 includes a step of providing a marking pen of claim 1 along with other steps set forth in the claim. Seeing that this claim is rejected over Palasis in view of DeSena, Palasis does not mark anything, such that erasing the indication does not apply to this reference or the Examiner's proposed combination.

Based upon the foregoing, Appellant continues to believe that pending claims of this application are in condition for allowance, and seeks the Board's concurrence at this time.

Dated: August 28, 2009

Respectfully submitted,

By

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